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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/655,109	09/05/2000	Mathieu Hubertus Maria Noteborn	LEBV.008.01US	7279

7590 10/01/2003

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EXAMINER
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WOITACH, JOSEPH T

ART UNIT	PAPER NUMBER
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1632

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DATE MAILED: 10/01/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

File

# Office Action Summary

Application No.  
09/655,109

Applicant(s)  
Noteborn et al.

Examiner  
Joseph Weitach

Art Unit  
1632



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Jul 19, 2002
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claims 1-33 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 6) ☐ Other:

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### **DETAILED ACTION**

This application filed September 5, 2000, claims benefit to EPO applications: EP 99202858.9 filed September 2, 1999; and EP 99203465.2, filed October 21, 1999.

Claims 1-33 are pending and currently under examination.

### ***Election/Restriction***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-11, 22-25, drawn to an isolated nucleic acid encoding an apoptin-associating proteinaceous substance, classified in class 536, subclass 23.5.
- II. Claims 12-16, 18, drawn to an isolated apoptin-associating proteinaceous substance, classified in class 530, subclass 350.
- III. Claim 17, drawn to an antibody that recognizes an isolated apoptin-associating proteinaceous substance, classified in class 424, subclass 130.1.
- IV. Claim 19-21, drawn to a method of inducing apoptosis by providing an proteinaceous apoptin-associating substance, classified in class 514, subclass 2.
- V. Claims 19-21, 26, drawn to a method of inducing apoptosis by providing an isolated polynucleotide that encodes a proteinaceous apoptin-associating substance, classified in class 514, subclass 44

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- VI. Claims 27-30, drawn to a method of detecting the presence of cancer cells comprising expressing a proteinaceous apoptin-associating substance in a cell and evaluating the number of cells that undergo apoptosis, classified in class 435, subclass 69.1
- VII. Claim 31-33, drawn to a method for determining a putative cancer-inducing agent comprising contacting a cell with a putative agent and expressing a proteinaceous apoptin-associating substance in a cell then evaluating the number of cells that undergo apoptosis, classified in class 435, subclass 69.1.

Claim 19-21 are generic to both groups IV and V, and will be examined to the extent that they encompass the elected invention. The breadth of the method in independent claim 19 recites and encompasses the use of two specific materially different products.

The inventions are distinct, each from the other because of the following reasons:

Inventions I-III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are drawn to materially different products have different physical properties not common among themselves. Further, each can be used in different methods requiring materially different method steps for use of each of the products.

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Inventions IV-VII are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are drawn to materially different methods requiring in some case different starting materials related to apoptin-associating proteinaceous substance, and each case different specific method steps to practice and different materials to practice the method steps.

Inventions I and V-VII are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, as exemplified by the multiple methods claimed, the polynucleotides can be used in various methods for various purposes. Additionally, the polynucleotide can be used to make recombinant proteins or provided in expression vectors to determine its role in a particular cell signaling pathway.

Inventions II and IV are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the protein can be used to study the biological properties or as an antigen to make antibodies.

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Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter and the search required for each of the groups is not co-extensive, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph Woitach whose telephone number is (703)305-3732.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah Reynolds, can be reached at (703)305-4051.

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Any inquiry of a general nature or relating to the status of this application should be directed to the Group analyst Dianiece Jacobs whose telephone number is (703) 308-2141.

Joseph T. Voitach

*Joe Voitach*  
AU1632